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| 09/941,698      | 08/30/2001  | Satoshi Nagano       | 503.40569X00        | 6215             |

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ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

EXAMINER

YOUNG, JOHN L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/941,698

Applicant(s)

NAGANO ET AL.

Examiner

John L Young

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UW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **FIRST ACTION REJECTION**

**(Paper# 9/7/2004)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; however, said drawings are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM OBJECTIONS**

2. Claim 15 is objected to because said claim suffers from inferential claiming. There is no antecedent basis for the elements: "the history information of the broadcasting receiver terminal" and "the play conditions determined. . . ."
3. Claim 22 is objected to because of a minor typographical error. In claim 22 at line 1 after the word "A" delete the word "method" and insert the words --advertisement information supply system--.

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**CLAIM REJECTIONS — 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-31 are rejected under 35 U.S.C. §103( a ) as being obvious over Horstmann US 6,285,985 (9/4/2001) [US f/d: 4/3/1998] (herein referred to as "Horstmann").

As per claim 1, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for providing advertisement information comprising; a step of storing advertisement information provided by a commercial sponsor into an advertisement storage means, a step of reading out advertisement information from said advertisement storage means, a step of sending said read-out advertisement information via an information transmission line, a step of

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receiving via the same information transmission line as said one or different from it the information on the history of a broadcasting receiver terminal having played said advertisement information, and a step of using said history information to calculate the charge for advertisement information to be paid by said commercial sponsor.”

Horstmann lacks an explicit recitation of the “history information” elements and limitations of claim 1 even though Horstmann implicitly shows all elements and limitations of claim 1.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 1 including the history information elements and limitations of claim 1, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 1, because modification and interpretation of the cited disclosure of Horstmann would have provided means to “*retrieve advertisements from an advertisement servers and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the “*advertisements are varied to retain the interest of the user. . . .*” (See Horstmann (col. 2, ll. 5-10)).

As per claims 2-14, Horstmann shows the method of claim 1 and subsequent base claims depending from claim 1.

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Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 2-14; however,

Horstmann lacks explicit recitation of some elements of claims 2-14, even though Horstmann as cited above implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 2-14 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows implicitly shows those elements and limitations of claims 2-14 which are not explicitly recited in Horstmann; and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as showing all of the elements and limitations of claims 2-14, because modification and interpretation of the cited disclosure of Horstmann would have provided means to *"retrieve advertisements from an advertisement servers and to display them to the user. . . ."* (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the *"advertisements are varied to retain the interest of the user. . . ."* (See Horstmann (col. 2, ll. 5-10)).

As per claim 15, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for providing advertisement information comprising; a step of sending advertisement information via the information

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transmission line, a step of receiving via the same information transmission line as said one or different from it the history information of the broadcasting receiver terminal having played said advertisement information, a step of using the play conditions determined between said history information and the broadcasting receiver terminal to determine if the conditions are satisfied or not, and a step of calculating the charge for the conditions not satisfied.”

Horstmann lacks an explicit recitation of the “history information” elements and limitations of claim 15 even though Horstmann implicitly shows all elements and limitations of claim 15.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 15 including the history information elements and limitations of claim 15, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 15, because modification and interpretation of the cited disclosure of Horstmann would have provided means to “*retrieve advertisements from an advertisement servers and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the “*advertisements are varied to retain the interest of the user. . . .*” (See Horstmann (col. 2, ll. 5-10)).

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Independent claim 16 is rejected for substantially the same reasons as independent claim 1.

As per claims 17-25, Horstmann shows the system of claim 16 and subsequent base claims depending from claim 16.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 17-25; however,

Horstmann lacks explicit recitation of some elements of claims 17-25, even though Horstmann as cited above implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 17-25 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows implicitly shows those elements and limitations of claims 17-25 which are not explicitly recited in Horstmann; and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as showing all of the elements and limitations of claims 17-25, because modification and interpretation of the cited disclosure of Horstmann would have provided means to “*retrieve advertisements from an advertisement servers and to display them to the user. . . .*” (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the “*advertisements are*



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*varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

As per claim 26, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A broadcasting receiver terminal comprising: a means for receiving program information broadcast by radio wave via satellite or terrestrial radio wave, and a means for outputting said received program information; said broadcasting receiver terminal characterized by further comprising: a step of storing the advertisement information broadcast in advance, a step of detecting the information on the sender of said advertisement information inserted in said program information and broadcast, and a step of outputting said advertisement information."

Horstmann lacks an explicit recitation of the "broadcast by radio wave via satellite or terrestrial radio wave. . . ." elements and limitations of claim 26 even though Horstmann (FIG. 1, el. 107) implicitly shows all elements and limitations of claim 26.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the "broadcast by radio wave via satellite or terrestrial radio wave. . . ." elements and limitations of claim 26, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 26, because modification and interpretation of the cited disclosure of Horstmann would have provided means to "*retrieve advertisements from an advertisement servers and to display them to*

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*the user. . . .*" (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the "*advertisements are varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

As per claims 27-31, Horstmann shows the system of claim 26 and subsequent base claims depending from claim 26.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 27-31; however,

Horstmann lacks explicit recitation of some elements of claims 27-31, even though Horstmann as cited above implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 27-31 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows implicitly shows those elements and limitations of claims 27-31 which are not explicitly recited in Horstmann; and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as showing all of the elements and limitations of claims 27-31, because modification and interpretation of the cited disclosure of Horstmann would have provided means to "*retrieve advertisements from an advertisement servers and to display them to the user. . . .*" (see Horstmann (col.

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2, ll. 1-10)), based on the motivation to modify Horstmann where the "*advertisements are varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

### CONCLUSION

5. Any response to this action should be mailed to:

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Any response to this action may be sent via facsimile to either:

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Hand delivered responses may be brought to:

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2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

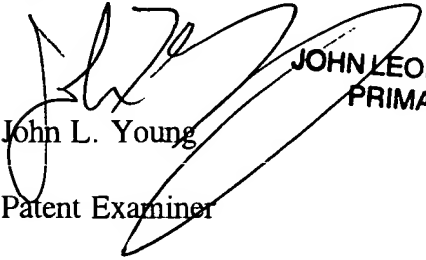
Serial Number: 09/941,698

(Nagano)

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER  
John L. Young  
Patent Examiner

September 7, 2004